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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,072	09/05/2003	Les Kollegian	DD-P0008	2071
36067	7590	09/21/2005	EXAMINER	
DALINA LAW GROUP, P.C. 7910 IVANHOE AVE. #325 LA JOLLA, CA 92037			NEWTON, JARED W	
			ART UNIT	PAPER NUMBER
			3634	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/605,072

Applicant(s)

KOLLEGIAN ET AL.

Examiner

Jared W. Newton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14,15,19,23,24 and 28-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14,15,19,23,24 and 28-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 19,23,24,28,29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948). | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. At the outset, please note that a new examiner different from the examiner of the previous correspondence has inherited the application No. 10/605072 of the present invention, and thus the previous correspondence may be altered in light of new research and or prior art.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 19, 23, 24, 28, and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
4. In regard to claim 19, the recitation "...wherein said open-faced housing is formed into a computer monitor mount open faced housing and wherein said computer monitor mount open-faced housing is located on the reverse side of a monitor mounted paper holder" is deemed subject matter not described in the specification in such a way as to enable one skilled in the art to make or use said monitor mount open faced housing or said mounted paper holder. The specification simply describes the possibility

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that the present invention can be mounted on a computer monitor or to the back of a paper holder (see [0087]). The drawings show said computer monitor mount and paper holder, but neither are labeled nor described in such a way as to enable one skilled in the art to make or use them in conjunction with the present invention (see FIG. 20).

5. In regard to claims 23, 24, 28, and 29, the recitation "...formed into a mailer..." is deemed subject matter not described in the specification in such a way as to enable one skilled in the art to make or use said mailer. The specification simply states that one embodiment of the present invention is capable of being mailed or transported.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claim 14 is rejected under 35 U.S.C. 102(a) as being clearly anticipated by U.S. Patent No. 6,059,123 to Cotutsca. Cotutsca discloses a media storage rack 10 comprising an open-faced housing configured to hold a plurality of multimedia disks, tapes, and the like. Cotutsca further discloses a plurality of outer width slots, or stepped formations 13, defined as the widest and shallowest slots on the front surface of the rack, said slots further comprising further indented width slots (see FIG. 2).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 5,632,374 to Fitzsimmons et al. Fitzsimmons discloses a compact disc transfer station 1 comprising a plurality of indented width slots (see FIG. 1).

Fitzsimmons does not show said width slots comprising further indented width slots, but It would have been obvious to one of ordinary skill in the art at the time of the invention to include further indented width slots within the width slots as disclosed by Fitzsimmons, as set forth in '123 to Cotutsca above. The motivation for including said further indented width slots would be to provide the device as disclosed by Fitzsimmons with a means of accommodating many different forms of media material.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over '123 to Cotutsca in view of U.S. Patent No. 5,033,629 to Caine. Cotutsca discloses an open-faced housing, and width slots comprising further indented width slots. Cotutsca does not disclose a conical indentation to hold a writing implement. Caine discloses a pen support stand 10 comprising holes 44 which are countersunk 46 to provide a conical recess for receiving a pen and pen support (see FIG. 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the pen supporting means as disclosed by Caine on the device as disclosed by Cotutsca. The motivation

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for said inclusion would be to provide said device with a means of supporting a pen, which is commonly used to label compact discs, DVD's, and the like. A means of supporting a pen would be beneficial in order to have a pen present at all times for quickly marking compact discs and the like that have been stored with data.

11. Claims 23, 24, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over '123 to Cotutsca in view of U.S. Patent No. 5,402,882 to Bandy et al. Cotutsca discloses a device including all of the limitations of claim 14, but does not disclose a disc storage indentation. Bandy discloses a compact disk holder 10 capable of transporting a single disk, comprising a disk indentation slot 58 (see FIG. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the disk indentation slot as disclosed by Bandy on either face of the device according to Cotutsca. The motivation for including a disk-supporting indentation would be to allow for a disk to be supported by and displayed on the front face of said device when the slots 13 are not holding disks or the like, or on the rear face when said slots are occupied (see FIG. 1, Cotutsca). It is noted that disk mailer devices are well known in the art, and shown in the devices according to U.S. Patent No. 6,449,654 to Huff et al, and U.S. Patent No. 6,505,737 to Sherman.

12. In regard to claims 30 and 31, the examiner takes official notice that the claimed methods are inherently obvious in the construction and use of the device according to '123 to Cotutsca. It is obvious that the intention of said device is to insert and remove various discs, tapes, and the like of various sizes in and out of said width slots. It would

have been obvious to one of ordinary skill in the art at the time of the invention that said method is the most efficient method of using said device.

Election/Restrictions

13. This application contains claims directed to the following patentably distinct species of the claimed invention:

- Claim 19 (see FIGs. 19 and 20) is directed to a distinct species of the invention according to claims 14 and 15. The claimed "Computer monitor mount open faced housing...located on the reverse side of a monitor mounted paper clip" is a distinct species of the "open-faced housing" of claims 14 and 15.
- Claims 23, 24, 28, and 29 (see FIGs. 27A, 27B, 28A, and 28B) are directed to a distinct species of the invention according to claims 14 and 15. The claimed "mailer" configuration is a distinct species of the "open-faced housing" of claims 14 and 15.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

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is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. Patent No. 5,215,198 to Sutton.
- U.S. Patent No. 6,279,757 to Hayoun.


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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared W. Newton whose telephone number is (571) 272-2952. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWN


Richard Chilcot
Supervisory Patent Examiner
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